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PATENT APPLICATION
ATTORNEY DOCKET NO. 200311589-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Stavely, et al.

Serial No.: 10/645,236

Examiner: Pritham D. Prabhakher

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Group Art Unit: 2622

Title: Photography system with remote control subject designation and digital framing

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Pre-Appeal Brief Request for Review

Sir:

Claims 1-3, 6-15, 18, 21-25, 28-32, 36-38, and 41-43 in the above-referenced patent application have been twice rejected. Applicant believes all of the claim rejections to be clearly erroneous, and requests a pre-appeal brief review as described in the Official Gazette, 12 July 2005.

The present invention relates to apparatus and methods for photography. In one embodiment, a remote control casts a light spot on a photographic subject, and a camera selects, based on the detected position of the light spot, a region from its field of view to photograph.

Rejection of claims 1, 6-15, 21, 23, 28-32, 36-38, 41, and 43 under 35 U.S.C. § 102(e)

The examiner has rejected claims 1, 6-15, 21, 23, 28-32, 36-38, 41, and 43 under 35 U.S.C. § 102(e) as being anticipated by Vaarala (U.S. Pat. No. 7,134,078). Applicant believes the rejection to be clearly erroneous because the examiner has failed to establish a *prima facie* case of anticipation.

Claim 1 and its dependents

Claim 1 recites

A photography system, comprising:

- a) a remote control that casts a light spot on a photographic subject; and
- b) a digital camera having a field of view, which digital camera can detect in its field of view the position of the light spot, and which digital camera ***selects a region from its field of view to photograph based on the detected position of the light spot.***

By contrast, Vaarala discloses a presentation system, in which “detection means”, which may include “camera means”, locates a “bright laser spot on the projected image.” (Vaarala column 4 lines 22-47) However, rather than selecting a region to photograph based on the detected position of the spot, the system of Vaarala uses its spot “to provide at least one control function for the presentation based on information from the detector means”. (Vaarala column 2 lines 4-6) At least two elements of Applicant’s claims are not disclosed in Vaarala.

1. Vaarala does not ***select[] a region ... to photograph***. Vaarala’s “camera means is adapted to take images of the display”. (Vaarala column 5 line 51). Presumably, this means the entire display, so that the laser spot may be tracked over the entire display. In support of the rejection, the examiner argues that Vaarala’s “entire image 11 is deemed a region that is selected by the camera 5 and is within the field of view of the camera.” (Paper 20070405 page 2). Applicant respectfully notes that if the camera of Vaarala always takes images of its entire field of view, then Vaarala’s system need not and does not ***select*** a region.

2. Even if, *arguendo*, Vaarala does select a region, the selection is not ***based on the detected position of the light spot***. The examiner has apparently ignored this limitation of Applicant’s claim 1, as in support of the rejection, the examiner only asserts that in the system of Vaarala, “[t]he camera means 5 can be used to track the location (region of field of view) of the spot (position of light spot) provided by means of the pointer device 4 relative to the image 11 (overall field of view)”. (Paper 20070405 page 3). The fact that Applicant’s region selection is ***based on the detected position of the light spot*** implies that the region selection can change as the position of the light spot changes within the camera’s field of view. Since Vaarala’s “region” is static, its selection cannot be ***based on the detected position of the light spot***.

Because Vaarala does not describe each and every element of Applicant’s claim 1, claim 1 is not anticipated by Vaarala. Claims 6-15 and 21 depend from claim 1 and add further limitations, and are therefore also not anticipated by Vaarala.

Claim 23 and its dependents

Claim 23 recites

A method of photography, comprising the steps of:

- a) detecting, in a field of view of a digital camera, a position of a light spot cast on a photographic subject by a remote control; and
- b) ***automatically selecting, based on the position of the light spot, a region from the camera's field of view to photograph.***

Claim 23 is not anticipated by Vaarala for at least the reasons given above with respect to claim 1. Specifically, Vaarala does not disclose ***automatically selecting ... a region from the camera's field of view to photograph***, and certainly does not disclose that any selected region is ***based on the position of the light spot***.

Because Vaarala does not describe each and every element of Applicant's claim 23, claim 23 is not anticipated by Vaarala. Claims 28-32, 36-38, and 41 depend from claim 23 and add further limitations, and are therefore also not anticipated by Vaarala.

Claim 43

Claim 43 recites

A photography system, comprising:

- a) means for detecting, in a field of view of a digital camera, the position of a light spot cast on a photographic subject using a remote control; and
- b) ***means for digitally framing a photograph based on the detected position of the light spot.***

Claim 43 is not anticipated by Vaarala for at least the reason that Vaarala does not disclose ***means for digitally framing a photograph based on the detected position of the light spot***. In support of the rejection, the examiner asserts that in Vaarala the "camera captures (frames) the selected image (12 in Figure 1) that is within the field of view of the spot from the pointer device." Leaving aside that the "field of view of the spot from the pointer device" does not make technical sense and is irrelevant and that the "selected image" 12 of Vaarala is an object in the projected image and not something selected by the camera, Vaarala does not perform digital framing, as digital framing is defined in Applicant's specification. (See specification page 6 lines 6-14).

Because Vaarala does not describe each and every element of Applicant's claim 43, claim 43 is not anticipated by Vaarala.

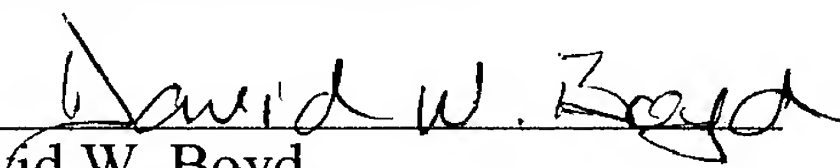
Rejection of claims 2, 3, 18, 22, 24, 25, and 42 under 35 U.S.C. § 103(a)

The examiner has rejected claims 2, 3, 18, 22, 24, 25, and 42 under 35 U.S.C. § 103(a) as being unpatentable over Vaarala. Applicant believes the rejection to be clearly erroneous because the examiner has failed to establish a *prima facie* case of obviousness.

Even in light of recent case law, it is still necessary to a *prima facie* case of obviousness that the cited art teach or suggest all of the elements of the rejected claims. (See *KSR International Co. v Teleflex Inc. et al.*, 550 U.S. ____ (2007)). Claims 2, 3, 18, and 22 depend from claim 1. Claims 24, 25, and 42 depend from claim 23. As has been shown above, claims 1 and 23 do not teach or suggest the claim limitations for which they are relied upon by the examiner. The examiner's *prima facie* case therefore fails, and claims 2, 3, 18, 22, 24, 25, and 42 are believed allowable.

Applicant believes both the rejection under 35 U.S.C. § 102(e) and the rejection under 35 U.S.C. § 103(a) to be clearly erroneous, and requests that they be reversed.

Respectfully submitted,

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